

Appl. No. 10/088,059

Amendment dated February 12, 2004

Reply to Non-Final Office Action of August 25, 2003

REMARKS

Claims 1-18 have been cancelled by an earlier amendment. Claims 19-38 were pending in this application prior to the submission of the foregoing amendment which cancels, without prejudice, claims 20 and 24. The subject matters of these two claims have now been incorporated into the respective independent claims from which they had originally depended.

The amendments to claims 19 and 23 reflect the restriction of the claimed subject matter to a subspecies of formula (I) in which only one of R1 to R4 is a C5 ring or a hydroxyalkyl group and X is hydrogen.

Claims 19-26, 28-30 36 and 38 stand rejected under 35 USC 103(a) as being unpatentable over Bil, U.S. Patent No. 3,632,582. Applicants respectfully traverse.

As indicated by the Examiner, Bil discloses hair dye compositions that contain nitro-p-phenylenediamine compounds. The 2-nitro-p-phenylenediamine compounds of the reference that are closest to Applicants' cyclopentyl (C5) compounds are those that replace the C5 moiety with C6. Even though Bil discloses that a C6 substituted nitro-p-phenylenediamine compound may be used in a hair dye formulation, he does not disclose that such a compound imparts a reddish color to the treated hair. Since no teaching is present in this reference that suggests that the C6 substituted compounds impart a reddish color to hair, it cannot therefore be implied that C5 substituted

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compounds would provide such a hair coloring effect. This reference is silent with regard to nitro-p-phenylenediamine compounds imparting a reddish tint to treated hair. However, instant claims 19 and 23, as amended, do disclose this distinguishing characteristic.

The Examiner asserts that "this property" (imparting a reddish color) "is inherent to N-cyclopentyl-2-nitro-phenylenediamine" and cites In re Papesch, 137 USPQ 42, (CCPA 1963) in support of this proposition. It is respectfully submitted that this line of reasoning should not apply in this instance. First of all, the subject matter of the disputed claim in In re Papesch was a compound. Applicants, however, do not claim a compound. Rather, they claim a method of use and a hair coloring formulation. Secondly, since Bil does not disclose "N-cyclopentyl-2-nitro-phenylenediamine", there can be no assumption as to any "inherent" property of this compound. The closest compound to N-cyclopentyl-2-nitro-phenylenediamine, a C6 substituted nitro-p-phenylenediamine, is not disclosed by this reference as imparting a reddish color. To establish inherency, the evidence "must make clear that the *missing descriptive matter is necessarily present in the thing described in the reference,*" (emphasis added). Continental Can Co. v. Monsanto Co., 20 USPQ2d 1746 (Fed Cir 1991). Since this property is not even mentioned in Bil, there can be no extrapolation leading to the premise that "N-cyclopentyl-2-phenylenediamine" itself exhibits the property of imparting a reddish color to hair. "Inherency, however, may not be established by probabilities or possibilities. The mere

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fact that a certain thing may result from a given set of circumstances is not sufficient." In re Oelrich, 212 USPQ 323 (CCPA 1981). This element is absent from the cited reference. Bil does not disclose or support the proposition that even the closest compound to Applicants' formula (I), a C6 substituted nitro-p-phenylenediamine, can tint hair red. It is respectfully submitted that Bil therefore does not render the claims against which it has been cited as being obvious.

Claims 27 and 31-34 are rejected under 35 USC 103(a) as being unpatentable over Bil as applied to claim 23, and further in view of Rose et al., U.S. Patent No. 4,900,327. While Rose et al. may disclose that hair dye formulations can contain various combinations of substantive dyes and primary and secondary intermediates, it does not follow that Applicants' N-cyclopentyl-p-phenylenediamine would impart reddish tones to such formulations, for the reasons stated above. Applicants respectfully request the withdrawal of this rejection.

Claims 35 and 37 are rejected under 35 USC 103(a) as being unpatentable over Bil as applied to claim 23, and further in view of Grollier et al., U.S. Patent No. 4,566,875. Applicants respectfully traverse. The disclosure of Grollier et al. fails to fill in the voids in the disclosure of Bil, as needed to support the grounds of rejection. The citation of this additional reference for its teaching that cationic polymers can be used in hair dye formulations does not strengthen the failure of Bil as the primary obviousness reference, as discussed previously

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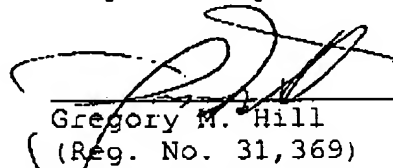
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herein. The removal of this rejection is therefore respectfully requested.

Applicants submit that the amended claims now set forth patentable subject matter. Accordingly, they cordially solicit the issuance of a notice of allowance for the subject matter claimed in this application. The Commissioner is authorized to charge any deficiency in the required fee or to credit any overpayment made in connection with the filing of this amendment to Deposit Account 01-1250.

Respectfully submitted,



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